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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,242	11/05/2001	Paul M. LoRocco	29062-12USPT	7748

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EXAMINER

COURSON, TANIA C

ART UNIT PAPER NUMBER

2859

DATE MAILED: 07/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,242

Applicant(s)

LOROCCO, PAUL M.

Examiner

Tania C. Courson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-4, 6, 10, 13-19 and 26-28 is/are rejected.
- 7) ☒ Claim(s) 5, 7-9, 11, 12 and 20-25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3 and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Ellig (US 5,862,603).

Ellig discloses in Figures 5-7, a sighting indicia comprising:

- a) an elongate pin (Fig. 6, sight pin 102) having a first end and a second end (Fig. 6);
- b) an elongate light-gathering optical fiber (Fig. 6, light gathering member 118) having a first end supported substantially at the first end of the elongate pin (Fig. 6) and visible when view a front of the elongate pin (Fig. 5), and having a second end with an end surface that is received in the second end of the elongate pin (Fig. 7) and obscured from view when viewing the front of the elongate pin (Fig. 5);
- c) wherein the elongate pin has a cavity in the second end (Fig. 7, opening 122) and wherein the second end of the light-gathering optical fiber is received within the cavity (Fig. 7);

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- d) a support fin (Fig. 6, sight support end 114) extending outwardly from the elongate pin which bridges at least a portion of the space between the light-gathering optical fiber and the elongate pin (Fig. 6), and;
- e) wherein the light-gathering optical fiber is supported substantially without slack between the first end of the optical fiber and the second end of the optical fiber (Fig. 6).

With respect to the preamble of the claim 1: the preamble of the claim has not been given any patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self – contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

3. Claims 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Ellig.

Ellig discloses in Figures 5-7, a sighting indicia comprising:

- a) at least one sight pin (Fig. 6, sight pin 102) having a shaft portion and a base portion (Fig. 6), the base portion adapted to engage the pin holder (Fig. 6) and having an elongate fiber-receiving aperture (Fig. 7, opening 122);
- b) a light-gathering optical fiber engaged by the shaft portion of the at least one sight pin (Fig. 6, light gathering member 118) and having one end closely received in

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- the elongate fiber-receiving aperture (Fig. 6), the light-gathering optical fiber further having an end surface at least partially covered by the sight pin (Fig. 6);
- c) wherein the shaft has a fiber-receiving aperture which intimately receives the light-gathering optical fiber (Fig. 6).

With respect to the preamble of the claim 16: the preamble of the claim has not been given any patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self – contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4, 6, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellig in view of Lorocco (5,956,854).

Ellig discloses a sighting indicia, as stated above in paragraph 2.

Ellig does not disclose wherein a cavity contains a light emitting member disposed adjacent a second end of a light-gathering optical fiber, wherein the light emitting member is

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tritium, wherein at least a portion of the cavity is threaded, and wherein at least one end of the elongate light-gathering optical fiber is flared.

With respect to wherein a cavity contains a light emitting member disposed adjacent a second end of a light-gathering optical fiber, wherein the light emitting member is tritium, wherein at least a portion of the cavity is threaded, and wherein at least one end of the elongate light-gathering optical fiber is flared. Lorocco teaches weapon sight that consists of wherein a cavity contains a light emitting member disposed adjacent a second end of a light-gathering optical fiber (Fig. 7 and column 5, lines 28-47), wherein the light emitting member is tritium (column 5, line 42), wherein at least a portion of the cavity is threaded (Fig. 7), and wherein at least one end of the elongate light-gathering optical fiber is flared (Fig. 7). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the sighting indicia of Ellig, so as to include a cavity containing a light emitting member and a flared end on the fiber, as taught by Lorocco, in order to provide a sight that is readily visible in the brightness of day or the darkness of night (column 1, lines 54-55).

With respect to the intended use of the apparatus, e.g. for attachment to an archery bow sight: It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

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6. Claims 18-19 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellig in view of Lorocco.

Ellig discloses a sighting indicia, as stated above in paragraph 3.

Ellig does not disclose wherein a base portion of a sight pin has a rectangular cross-section, wherein a base portion has an axial bore and at least a portion of the axial bore is threaded to receive and engage a threaded male member on a pin holder, wherein the base portion contains a light emitting member adjacent to the light-gathering optical fiber, wherein the end of the light-gathering optical fiber received in the fiber-receiving aperture is flared, and wherein the opposing end of the light-gathering optical fiber is flared.

With respect to claim 4: the shape of the base portion of a sight pin, i.e., rectangular cross-section, absent any criticality, are only considered to be obvious modifications of the shape of the base portion of a sight pin (sight pin 102) disclosed by Ellig as the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention. See *In re Dailey*, 149 USPQ 47 (CCPA 1976).

With respect to wherein a base portion has an axial bore and at least a portion of the axial bore is threaded to receive and engage a threaded male member on a pin holder, wherein the base

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portion contains a light emitting member adjacent to the light-gathering optical fiber, wherein the end of the light-gathering optical fiber received in the fiber-receiving aperture is flared, and wherein the opposing end of the light-gathering optical fiber is flared. Lorocco teaches weapon sight that consists of wherein a base portion has an axial bore and at least a portion of the axial bore is threaded to receive and engage a threaded male member on a pin holder (Fig. 10), wherein the base portion contains a light emitting member adjacent to the light-gathering optical fiber (Fig. 10, light emitting member 36), wherein the end of the light-gathering optical fiber received in the fiber-receiving aperture is flared (Fig. 7), and wherein the opposing end of the light-gathering optical fiber is flared (Fig. 7). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the sighting indicia of Ellig, so as to include an axial bore containing a light emitting member and flared ends on the fiber, as taught by Lorocco, in order to provide a sight that is readily visible in the brightness of day or the darkness of night (column 1, lines 54-55).

Allowable Subject Matter

7. Claims 5, 7-9, 11-12 and 20-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed on May 13, 2003 have been considered but are moot in view of the new ground(s) of rejection.

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9. The 35 USC 112 claim rejections of the last Office action are withdrawn.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania C. Courson whose telephone number is (703) 305-3031. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (703) 308-3875. The fax number for this Organization where this application or proceeding is assigned is (703) 308-7724.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DIEGO F.F. GUTIERREZ
SUPERVISORY PATENT EXAMINER
GROUP ART UNIT 2859

TCC
July 21, 2003